

allowed, it is respectfully requested that the Examiner withdraw the final rejection and provide detailed grounds for the non-allowance of these claims.

Regarding claims 1-13, for the reasons further detailed below, it is respectfully submitted that the prior art upon which the Examiner relies fails to establish a *prima facie* case of obviousness, and, even if it did, any *prima facie* case is factually rebutted.

I. Hazard and Semmens Fail to Establish a *Prima Facie* Case of Obviousness.

In order to establish a *prima facie* case of obviousness, the references relied upon by the Examiner must teach each and every element set forth in a claim. Where the Examiner relies upon more than one reference, the motivation to combine must be found in the prior art (and not based upon applicant's disclosure). To quote MPEP § 2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not

based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Because the prior art relied upon by the Examiner teaches away from the combination of Hazard and Semmens, these references fail to establish a *prima facie* case of obviousness.

A. When Viewed in Their Entirety, Hazard and Semmens Teach Away from the Combination Made by the Examiner.

When considering prior art references, the Examiner may not only focus upon aspects supporting a rejection but must also consider portions of the prior art references that teach away from the claimed invention. To quote MPEP § 2141.02(VI):

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

As previously explained at length by applicant, Hazard is directed to a method of sealing a seam between two sheets of dry wall. To this end, Hazard teaches the use of joint compound. As is well-known in the art and suggested by Hazard, joint compounds will not have sand or similar particles because sand or similar particles will cause

"chatter" when a taping knife is drawn along the seam. The Examiner does not dispute this clear teaching of Hazard. In fact, the Examiner's rejection simply ignores this teaching which is plainly away from applicant's claimed invention. Because, as the Examiner admits, Semmens fails to teach or fairly suggest applicant's claimed method of scraping with a rough trowel to remove particles, when these prior art references are viewed as a whole, they teach away from the inclusion of sand in the method taught by Hazard. As the MPEP makes clear, "[i]t is improper to combine references where the references teach away from their combination." MPEP 2145(X)(D)(2).

B. Use of the Compound Taught by Semmens with the Method Taught by Hazard Would Render the Prior Art Unsuitable for Its Intended Use.

"The mere fact that references can be combined or modified does not render the resulting combination obvious, unless the prior art also suggests the desirability of the combination." MPEP § 2143.01(III). "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V).

As applicant has previously explained, using the composition taught by Semmens in the method taught by Hazard would render that method unsatisfactory for its intended purpose. Hazard clearly teaches away from the inclusion of sand or similar particles because they cause undesirable "chatter." For this further reason, the combination of these references fails to establish a *prima facie* case of obviousness.

C. The Examiner's Rational for Combining Hazard and Semmens Is Wrong.

Against the teachings of Hazard and Semmens, the Examiner asserts (without citation to any prior art reference) that this combination "would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the steps of SEMMENS with the step of using a trowel, as taught by HAZARD, in order to improve adhesion of the concrete to the substrate while also preparing the surface for exterior coatings." (Office Action mailed January 4, 2006, Page 2.) The assertion is factually wrong and totally unsupported by any citation to prior art.

Scraping the surface of an applied mortar after it has hardened would not "improve adhesion of the concrete to the

substrate." If it had any affect on adhesion with the substrate, it would likely reduce (not improve) the adhesion by the stress and strain caused by rubbing the rough trowel against the hardened composition.

D. The Examiner's Rejection Fails to Address Express Elements of the Claims.

Even accepting for purposes of argument that the Examiner had properly combined Hazard and Semmens (which is clearly not the case), this combination still fails to teach or fairly suggest express elements of the claims and so fails to establish a *prima facie* case of obviousness.

As set forth in MPEP § 2143.03:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 8 expressly recites that the step of scraping with a rough trowel occurs after the composition has hardened sufficient to prevent reformation. To quote the precise language, Claim 8 recites:

allowing the resulting composition to harden, after the step of applying the resulting composition and before the step of scraping the resulting composition, for a time sufficient: (a) to prevent reformation of the resulting composition; (b) to

prevent uneven scraping of the resulting composition by the rough trowel; and (c) to prevent any of the resulting composition from sticking to the rough trowel.

The rejection completely fails to address this express element of Claim 8. Moreover, Hazard (which is the reference relied upon by the Examiner to teach the claimed method) consistently teaches that the trowel is used while the joint compound is still "viscous." (See, e.g., column 1, lines 11-18; column 8, lines 15, 25 and 47.) Against this teaching, the rough trowel is used after the mortar has hardened sufficient to prevent reformation. Because Hazard clearly teaches away from this express element (and by the Examiner's own admission Semmens does not teach the claimed step), this combination of references fails to establish a *prima facie* case of obviousness.

II. Accepting for Purposes of Argument that the Examiner Had Established a *Prima Facie* Case of Obviousness (Which Is Not in Fact the Case), the Declaration of Felipe J. Acosta, Ph.D., Rebutts the Examiner's Rejection of the Claimed Invention.

In the final rejection set forth in the Office Action mailed January 4, 2006, the Examiner contended that applicant's argument contradicted itself and that it failed to consider the teachings of the prior art as a whole. In

order to squarely rebut these assertions, applicant needs the further factual support detailed in the Declaration of Felipe J. Acosta, Ph. D., which is included. Because this argument was first advanced by the Examiner in the final rejection, applicant did not have an earlier opportunity to present this declaration. Accordingly, it is respectfully submitted that it should be considered by the Examiner.

As MPEP § 2142 expressly provides:

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. (Underlining supplied.)

For the reasons set forth in the declaration, it is respectfully submitted that the Examiner's combination of Hazard and Semmens contradicts their teachings when viewed as a whole.

III. The Examiner's Response Misconstrues Applicant's Arguments and Misapprehends the Prior Art.

The final rejection included a response to applicant's prior arguments. It is respectfully submitted that this

misconstrues applicant's arguments and misapprehend the prior art.

It is undisputed that Hazard teaches the application of a joint compound that does not include sand or similar particles. This is consistent with methods generally used in the art. Because the prior art teaches the removal of any sand or like size particles from a joint compound, they obviously teach away from the claims that expressly recite the inclusion of such particles and likewise teaches away from the combination with a reference teaching a concrete mixture that includes sand particles or similar particles. The Examiner's assertion that this argument somehow contradicts itself is simply misplaced and ignores the clear teachings of the prior art.

The Examiner also argues that Hazard is not being used to teach the material and that this teaching is instead drawn from Semmens. The basic flaw in this argument is that the Examiner cannot pick and choose elements from different references merely to meet the elements of a claim. The prior art (and not applicant's disclosure of the invention) must provide the motivation to combine relevant teachings. For the reasons that have been detailed (and unrebutted by the Examiner), the use of a joint compound containing sand or similar particles in the

method taught by Hazard runs squarely against the teachings of the prior art. The simple point is that the prior art must provide the motivation to combine their relevant teachings. In fact, when viewed as a whole, the prior art relied upon by the Examiner teaches away from the combination of Hazard and Semmens. (This is a point the Examiner appears to concede as no citation to any prior art reference is provided to support this combination of references.)

IV. The Newly Added Claims Stand in Condition for Allowance.

Although the Examiner issued a final rejection, claims 14 - 28 were not addressed. Accordingly, it is respectfully submitted that the final rejection is improper and should be withdrawn. Applicant respectfully requests that the Examiner consider all of the evidence that has been submitted in consideration of these claims.

Moreover, applicant respectfully notes that the newly added claims include distinct elements in addition to those recited in rejected claims 1-13. For example, newly added claim 16 recites that:

the step of scraping the rough trowel against the resulting composition further comprises removing portions of the uneven surface that lie above the

plane so that the surface becomes even without further application of the resulting composition.

This is directly against the teaching of Hazard relied upon by the Examiner which applies additional coats to fill in cracks and divots. (Column 3, lines 26-32.)

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the final rejection should be withdrawn and that all claims stand in condition for allowance. The Examiner's further consideration and favorable action are respectfully requested.

Respectfully Submitted,

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